

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF CALIFORNIA

RILLITO RIVER SOLAR, LLC dba
ECOFASTEN SOLAR,

Plaintiff,

v.

BAMBOO INDUSTRIES, LLC dba
SOLARHOOKS,

Defendant.

No. 2:17-cv-00181-TLN-CKD

ORDER

This matter is before the Court on Defendant Bamboo Industries, LLC’s (“Defendant”) Motion for Summary Judgment. (ECF No. 64.) Plaintiff Rillito River Solar, LLC (“Plaintiff”) filed an opposition. (ECF No. 65.) Defendant filed a reply. (ECF No. 67.) Also before the Court is Plaintiff’s Motion to Strike. (ECF No. 69.) Defendant filed an opposition. (ECF No. 70.) Plaintiff filed a reply. (ECF No. 71.) For the reasons set forth below, the Court GRANTS Defendant’s motion and DENIES Plaintiff’s motion as moot.

///
///
///
///
///

1 **I. FACTUAL AND PROCEDURAL BACKGROUND**

2 Plaintiff accuses Defendant of infringing five patents: U.S. Patent Nos. 8,153,700 (“the
3 ’700 patent”); 9,134,044 (“the ’044 patent”); 9,447,988 (“the ’988 patent”); 9,774,292 (“the ’292
4 patent”); and 9,793,853 (“the ’853 patent”) (collectively, the “Asserted Patents”). (ECF No. 66 at
5 2.) The Asserted Patents are generally directed to roof mounting systems used to mount
6 components such as solar panels, snow fences, or antennas to a roof. (*Id.*)

7 Defendant sells roof mount hardware for solar panels, including the “Composition
8 Flashing Kit” and the “Tile Replacement System” products. (*Id.*) The Composition Flashing Kit
9 includes: (1) a lag screw; (2) an EPDM bonded washer; (3) an L-foot bracket; (4) an EPDM seal;
10 and (5) a flashing. (*Id.* at 3.) The Tile Replacement System includes: (1) a stainless-steel bolt;
11 (2) a stainless-steel EPDM bonded washer; (3) an L-foot bracket; (4) an EPDM seal; (5) a
12 flashing (S-tile version shown); (6) a stainless-steel base; and (7) 3.5” #14 Lag Screws. (*Id.* at 5.)



22 Plaintiff alleges the Composition Flashing Kit is an infringing product for the ’700 patent
23 and the Tile Replacement System is an infringing product for the ’044, ’988, ’292, and ’853
24 patents. (*Id.* at 6.) Defendant filed the instant motion for summary judgment on March 21, 2019,
25 arguing that Plaintiff has failed to show infringement and, alternatively, the patents at issue are
26 not valid. (ECF No. 64.)

27 ///

28 ///

1 **II. STANDARD OF LAW**

2 Summary judgment is appropriate when the moving party demonstrates no genuine issue
3 of any material fact exists and the moving party is entitled to judgment as a matter of law. Fed.
4 R. Civ. P. 56(a); *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 157 (1970). Under summary
5 judgment practice, the moving party always bears the initial responsibility of informing the
6 district court of the basis of its motion, and identifying those portions of “the pleadings,
7 depositions, answers to interrogatories, and admissions on file together with affidavits, if any,”
8 which it believes demonstrate the absence of a genuine issue of material fact. *Celotex Corp. v.*
9 *Catrett*, 477 U.S. 317, 323 (1986). “[W]here the nonmoving party will bear the burden of proof
10 at trial on a dispositive issue, a summary judgment motion may properly be made in reliance
11 solely on the pleadings, depositions, answers to interrogatories, and admissions on file.” *Id.* at
12 324 (internal quotation marks omitted). Indeed, summary judgment should be entered against a
13 party who does not make a showing sufficient to establish the existence of an element essential to
14 that party’s case, and on which that party will bear the burden of proof at trial.

15 If the moving party meets its initial responsibility, the burden then shifts to the opposing
16 party to establish that a genuine issue as to any material fact does exist. *Matsushita Elec. Indus.*
17 *Co. v. Zenith Radio Corp.*, 475 U.S. 574, 585–87 (1986); *First Nat’l Bank of Ariz. v. Cities Serv.*
18 *Co.*, 391 U.S. 253, 288–89 (1968). In attempting to establish the existence of this factual dispute,
19 the opposing party may not rely upon the denials of its pleadings, but is required to tender
20 evidence of specific facts in the form of affidavits, and/or admissible discovery material, in
21 support of its contention that the dispute exists. Fed. R. Civ. P. 56(c). The opposing party must
22 demonstrate that the fact in contention is material, *i.e.*, a fact that might affect the outcome of the
23 suit under the governing law, *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986), and that
24 the dispute is genuine, *i.e.*, the evidence is such that a reasonable jury could return a verdict for
25 the nonmoving party. *Id.* at 251–52.

26 In the endeavor to establish the existence of a factual dispute, the opposing party need not
27 establish a material issue of fact conclusively in its favor. It is sufficient that “the claimed factual
28 dispute be shown to require a jury or judge to resolve the parties’ differing versions of the truth at

1 trial.” *First Nat’l Bank of Ariz.*, 391 U.S. at 288–89. Thus, the “purpose of summary judgment is
2 to ‘pierce the pleadings and to assess the proof in order to see whether there is a genuine need for
3 trial.’” *Matsushita Elec. Indus. Co.*, 475 U.S. at 587 (quoting Rule 56(e) advisory committee’s
4 note on 1963 amendments).

5 In resolving the summary judgment motion, the court examines the pleadings, depositions,
6 answers to interrogatories, and admissions on file, together with any applicable affidavits. Fed.
7 R. Civ. P. 56(c); *SEC v. Seaboard Corp.*, 677 F.2d 1301, 1305–06 (9th Cir. 1982). The evidence
8 of the opposing party is to be believed and all reasonable inferences that may be drawn from the
9 facts pleaded must be drawn in favor of the opposing party. *Anderson*, 477 U.S. at 255.
10 Nevertheless, inferences are not drawn out of the air, and it is the opposing party’s obligation to
11 produce a factual predicate from which the inference may be drawn. *Richards v. Nielsen Freight*
12 *Lines*, 602 F. Supp. 1224, 1244–45 (E.D. Cal. 1985), *aff’d*, 810 F.2d 898 (9th Cir. 1987). Finally,
13 to demonstrate a genuine issue that necessitates a jury trial, the opposing party “must do more
14 than simply show that there is some metaphysical doubt as to the material facts.” *Matsushita*
15 *Elec. Indus. Co.*, 475 U.S. at 586. “Where the record taken as a whole could not lead a rational
16 trier of fact to find for the nonmoving party, there is no ‘genuine issue for trial.’” *Id.* at 587.

17 III. ANALYSIS

18 Plaintiff concedes the Court should grant Defendant’s motion as to Claims Two, Three,
19 and Five, which correspond to the ’044, ’988, and ’853 patents. (ECF No. 65 at 5.) As such, the
20 Court GRANTS Defendant’s motion as to the infringement claims alleged in Claims Two, Three,
21 and Five. The Court will only address the parties’ remaining arguments as to Claims One and
22 Four, which correspond to the ’700 and ’292 patents.¹

23 ///

24
25 ¹ As will be discussed, the Court finds Plaintiff has not met its burden to show Defendant
26 infringed any of the Asserted Patents. Therefore, the Court need not and does not address
27 invalidity, which Defendant raised as an affirmative defense. *See Multiform Desiccants, Inc. v.*
28 *Medzam, Ltd.*, 133 F.3d 1473, 1481 (Fed. Cir. 1998); *see also MEMC Elec. Materials v.*
Mitsubishi Materials Silicon Corp., No. C 01-4925 SBA, 2004 WL 5363615, at *2 (N.D. Cal.
Apr. 23, 2004) (“[U]pon a finding that the patent at issue was not infringed, the Court may, in its
discretion, decline to reach the issue of validity.”).

1 A. Claim One ('700 Patent)

2 Defendant argues it has not infringed the '700 patent. (ECF No. 64-1 at 10.) In
3 opposition, Plaintiff argues the Composition Flashing Kit infringes the '700 patent because it
4 “indisputably contains the claimed elements disclosed” therein. (ECF No. 65 at 7.)

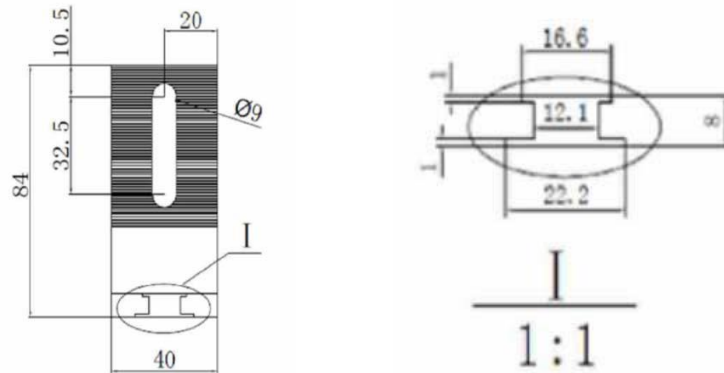
5 “An infringement analysis involves the two-step process of construing the claims and
6 comparing the properly construed claims to the accused product.” *Tinnus Enter., LLC v.*
7 *Telebrands Corp.*, 846 F.3d 1190, 1203 (Fed. Cir. 2017) (internal citation omitted). “To prevail,
8 the plaintiff must establish by a preponderance of the evidence that the accused device infringes
9 one or more claims of the patent either literally or under the doctrine of equivalents.” *Bayer AG*
10 *v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000). “Since the ultimate
11 burden of proving infringement rests with the patentee, an accused infringer seeking summary
12 judgment of noninfringement may meet its initial responsibility either by providing evidence that
13 would preclude a finding of infringement, or by showing that the evidence on file fails to
14 establish a material issue of fact essential to the patentee’s case.” *Novartis Corp. v. Ben Venue*
15 *Labs., Inc.*, 271 F.3d 1043, 1046 (Fed. Cir. 2001). If the moving party meets this initial burden,
16 the burden shifts to the party asserting infringement to set forth, by affidavit or as otherwise
17 provided in Rule 56, “specific facts showing there is a genuine issue for trial.” *Anderson*, 477
18 U.S. at 248. “[A] party does not meet this evidentiary threshold merely by submitting the
19 affidavit of an expert who opines that the accused device meets the claim limitations.” *Novartis*,
20 271 F.3d at 1051.

21 The Court will address Defendant’s arguments as to literal infringement and the doctrine
22 of equivalents in turn.

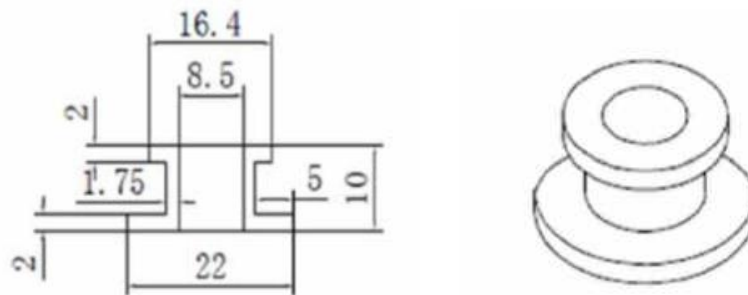
23 i. *Literal Infringement*

24 It is undisputed that Plaintiff’s claims as to the '700 patent require a bracket aperture
25 “having a generally frustoconical shape” and a seal “having a generally frustoconical shape.”
26 (ECF No. 66 at 7.) The parties agree that under the operative claim construction, “having a
27 generally frustoconical shape” means “having, for the most part, a shape of a cone without the
28 narrowest part of the cone (the cone may have a rounded, flat, nearly flat, or other upper portion

1 instead).” (*Id.* at 8.) Defendant argues there is no literal infringement because neither the
2 Composition Flashing Kit’s bracket aperture nor the seal have “for the most part, a shape of a
3 cone.” (ECF No. 64-1 at 10.) Defendant cites the following undisputed images of the bracket
4 aperture in the Composition Flashing Kit (circled below):



5
6
7
8
9
10
11 (ECF No. 66 at 10.) Defendant also cites the following undisputed images of the seal in the
12 Composition Flashing Kit:

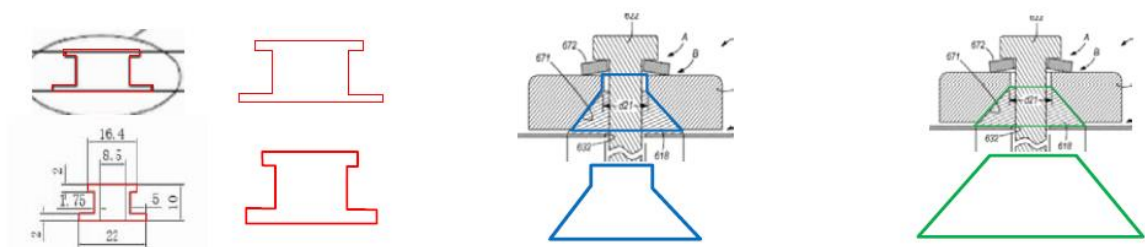


13
14
15
16
17
18
19 (*Id.*)

20 In addition, Defendant cites the declaration of Philip Dregger, a Registered Roof
21 Consultant and professional engineer Defendant retained to provide an expert opinion relating to
22 questions of patent validity and patent infringement. (ECF No. 64-13 at 1.) Dregger states “a
23 cone, under the customary and ordinary meaning that a person having ordinary skill in the art
24 would give it in light of the specification of the ’700 patent. . . , [is] a shape having a curved base
25 (e.g., a circle), a vertex, and sides formed by straight lines connecting the vertex to the curved
26 base.” (*Id.* at 27.) Dregger further states, “[o]ne distinguishing characteristic of a cone is a
27 constant, straight, sloped side — since the sides of a cone are formed by straight lines connecting
28 the edge of the base to the vertex, a cone’s sides follow a constant, straight slope.” (*Id.*) Dregger

1 opines that the shape of the bracket aperture and seal in the Composition Flashing Kit are, for the
2 most part, cylindrical — *not* conical. (*Id.* at 28.) Defendant also notes that Plaintiff did not
3 submit an expert report on the issues of infringement. (ECF No. 64-1 at 11.)

4 Defendant lastly points to Figure 53, which includes “substantially” or “generally”
5 frustoconical shapes according to the ’700 patent specification. (*Id.* at 11–12 (citing ECF No. 64-
6 3 at 29, 39).) Defendant argues Figure 53 depicts shapes with constantly sloped sides that are
7 characteristic of a cone and substantially differ from the shape of the seal and bracket aperture of
8 the Composition Flashing Kit. (*Id.* at 12.) Defendant provides a table (reproduced below) to
9 show the comparison: (1) an outline (left, in red) of the bracket aperture and seal in the
10 Composition Flashing Kit; (2) an outline (middle, in blue) of a bracket aperture in Figure 53,
11 which the ’700 patent describes as “having a substantially frustoconical shape”; and (3) an outline
12 (right, in green) of a seal in Figure 53, which the ’700 patent describes as “having a generally
13 frustoconical shape.” (*Id.*)



14
15
16
17
18
19 In opposition, Plaintiff argues “[w]hile the Composition Flashing Kit’s seal and bracket
20 aperture may have a *substantially cylindrical* shape, that does not preclude that they too have a
21 *generally frustoconical* shape.” (ECF No. 65 at 7 (emphasis in original).) Plaintiff contends the
22 Court should not use Defendant’s narrow definition of a cone and should instead allow a jury to
23 make the determination of whether the shapes at issue meet the broader definition of “generally
24 frustoconical” agreed to by the parties. (*Id.*) Plaintiff also challenges Defendant’s definition by
25 submitting a declaration of Brian Stearns, the inventor of the ’700 patent.² (*Id.* at 9 (citing ECF

26
27
28
² Defendant argues in reply that Stearns’s declaration is inadmissible. (ECF No. 67 at 2.)
However, because Stearns’s declaration does not alter the Court’s ruling, the Court does not and
need not address Defendant’s objection.

1 No. 66-1.) Plaintiff argues Stearns is a person of ordinary skill in the art who is of the opinion
2 that “an object ‘having, for the most part, a shape of a cone’ need not have sloped sides or have
3 ‘curved base, a vertex, and sides formed by [straight] lines connecting the vertex to the curved
4 base.’” (ECF No. 66-1 at 3.) Stearns asserts “[w]hile a cone certainly could have these
5 characteristics, an object ‘having, for the most part, a shape of a cone’ is not limited to such a
6 basic description.” (*Id.*)

7 Plaintiff further argues “Defendant cannot earnestly claim that the shape disclosed in the
8 ’700 [patent] is limited *only* to [the] particular embodiment of a cone [described by Degger] as it
9 would require the Court to ignore specification language and other embodiments.” (ECF No. 65
10 at 9 (emphasis in original).) More specifically, Plaintiff cites Figures 6, 7, 8 and 13 — which
11 Plaintiff argues illustrate other embodiments “having a generally frustoconical shape” — and
12 other specification language to argue that the bracket aperture and seal can be *both* substantially
13 cylindrical *and* generally frustoconical. (*Id.* at 9–10 (citing ECF No. 64-3 at 8, 10, 12).) Plaintiff
14 argues “[t]he ’700 patent clearly discloses a range of shapes that constitute ‘having a generally
15 frustoconical shape’ that indisputably covers the Composition Flashing Kit.” (*Id.* at 10.)

16 In reply, Defendant argues the parties’ agreed-to construction of “generally frustoconical”
17 requires a cone and Plaintiff “has failed to point to any characteristic of the accused seal or
18 bracket aperture that is conical.” (ECF No. 67 at 4.) As to Plaintiff’s reliance on Figures 6, 7, 8,
19 and 13, Defendant argues Figure 13 does not show a “frustoconical” or “conical” bracket aperture
20 and Figures 6–8 show a seal with constantly sloped sides (the distinguishing characteristic of a
21 cone), unlike the seal in the Composition Flashing Kit. (*Id.* at 5.) Defendant stresses that Figure
22 53 is the best example from the ’700 patent specification to guide the Court in what “having, for
23 the most part, a shape of a cone” means because it is the only embodiment described as having a
24 “generally frustoconical” seal and a “substantially frustoconical” bracket aperture. (*Id.*)

25 The Court agrees with Defendant that Plaintiff has not shown literal infringement. “To
26 prove literal infringement, the patentee must show that the accused device contains every
27 limitation in the asserted claims . . . If even one limitation is missing or not met as claimed, there
28 is no literal infringement.” *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir.

1 1998). Plaintiff’s Infringement Contentions allege Defendant infringes claims 23, 24, 27, and 33–
2 35 of the ’700 patent. (ECF No. 66 at 7.) Those claims require, among other things, a bracket
3 aperture and seal “having a generally frustoconical shape” (ECF No. 64-3 at 40), which the
4 parties have agreed means “having, for the most part, a shape of a cone without the narrowest part
5 of the cone (the cone may have a rounded, flat, nearly flat, or other upper portion instead).” (*Id.*
6 at 8.) The disagreement lies in the meaning of “having, for the most part, a shape of a cone.”

7 Although Plaintiff argues the issue should go before a jury, “a mere dispute over the
8 meaning of a term does not itself create an issue of fact.” *Johnston v. IVAC Corp.*, 885 F.2d
9 1574, 1579 (Fed. Cir. 1989). “When legal ‘experts’ offer their conflicting views of how the
10 patent should be construed, or where the legal expert’s view of how the patent should be
11 construed conflicts with the patent document itself, such conflict does not create a question of fact
12 nor can the expert opinion bind the court or relieve the court of its obligation to construe the
13 claims according to the tenor of the patent.” *Markman v. Westview Instruments, Inc.*, 52 F.3d
14 967, 983 (Fed. Cir. 1995). In construing claim language, “the words of a claim are generally
15 given their ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed.
16 Cir. 2005) (internal quotation marks and citation omitted). “The ordinary and customary meaning
17 of a claim term is the meaning that the term would have to a person of ordinary skill in the art in
18 question at the time of the invention.” *Id.* at 1313. “[T]he person of ordinary skill in the art is
19 deemed to read the claim term not only in the context of the particular claim in which the
20 disputed term appears, but in the context of the entire patent, including the specification.” *Id.* “In
21 some cases, the ordinary meaning of claim language as understood by a person of skill in the art
22 may be readily apparent even to lay judges, and claim construction in such cases involves little
23 more than the application of the widely accepted meaning of commonly understood words.” *Id.*
24 at 1314. “In such circumstances, general purpose dictionaries may be helpful.” *Id.*

25 Defendant’s definition is well-supported. Defendant’s expert defines a cone as “a shape
26 having a curved base (e.g., a circle), a vertex, and sides formed by straight lines connecting the
27 vertex to the curved base” which has sides that “follow a constant, straight slope.” (ECF No. 64-
28 13 at 27.) As an example, Defendant points to Figure 53, which the specification describes as

1 being “frustoconical” and which has sloped sides consistent with Defendant’s definition. (ECF
2 No. 64-3 at 29, 39.) It also bears mentioning that Defendant’s definition is consistent with
3 Merriam-Webster, which defines “cone” as follows: “a solid generated by rotating a right triangle
4 about one of its legs”; “a solid bounded by a circular or other closed plane base and the surface
5 formed by line segments joining every point of the boundary of the base to a common vertex”;
6 and “a surface traced by a moving straight line passing through a fixed vertex.” Merriam-
7 Webster, <https://www.merriam-webster.com/dictionary/cone> (last visited October 19, 2021).

8 Although Plaintiff asks the Court not to use Defendant’s definition, Plaintiff does not
9 provide an alternative definition. Instead, Plaintiff cites Stearns’s assertion that while a cone
10 “certainly could” have the characteristics in Defendant’s definition, it “is not limited to such a
11 basic description.” (ECF No. 66-1 at 3.) Not only does Plaintiff fail to expand on Stearns’s
12 vague statement, but it also fails to provide any evidence to suggest the bracket aperture and seal
13 in the Composition Flashing Kit have a shape that is at all — much less “for the most part” — the
14 shape of a cone under any rational interpretation of the phrase. Plaintiff relies on Figures 6, 7, 8,
15 and 13 but fails to cite any part of the specification indicating that those figures depict
16 “frustoconical” shapes. (ECF No. 65 at 9.) To the contrary, Plaintiff cites a portion of the
17 specification stating that Figure 13 discloses an embodiment that has a “substantially cylindrical”
18 bracket aperture. (*Id.*) As for Figures 6–8, the Court agrees with Defendant that those figures
19 depict a seal that appears to conform to Defendant’s definition and differs from the seal in the
20 Composition Flashing Kit. (ECF No. 64-3 at 8–10.)

21 In sum, Defendant has provided a definition of cone that is consistent with the ordinary
22 meaning of the term, consistent with the specification, and is essentially un rebutted. *See K.H.S.*
23 *Musical Instrument Co. v. Ultimate Support Sys., Inc.*, No. LACV1102455JAKEX, 2013 WL
24 12244318, at *5 (C.D. Cal. Mar. 4, 2013) (concluding that the plaintiff had not provided any
25 reason for the court to interpret a disputed term in a manner inconsistent with its well-accepted
26 meaning and noting that Plaintiff’s expert’s “unsupported opinion that perpendicular could mean
27 other angles [was] immaterial”); *see also Phillips*, 415 F.3d at 1318 (“[C]onclusory, unsupported
28 assertions by experts as to the definition of a claim term are not useful to a court.”). Defendant

1 has also provided evidence that the Composition Flashing Kit does not contain every limitation in
2 the asserted claims — namely, a seal and bracket aperture with a “generally frustoconical shape.”
3 *See Novartis*, 271 F.3d at 1051. For its part, Plaintiff has not met its burden to set forth “specific
4 facts showing there is a genuine issue for trial” as to whether the seal and bracket aperture in the
5 Composition Flashing Kit have a “generally frustoconical shape.” *See Anderson*, 477 U.S. at 248.
6 Accordingly, the Court GRANTS summary judgment in favor of Defendant on the issue of literal
7 infringement of the ’700 patent.

8 *ii. Doctrine of Equivalents*

9 Defendant also argues Plaintiff fails to “provide any of the required analysis to allege
10 infringement under the doctrine of equivalents.” (ECF No. 64-1 at 5.) Plaintiff does not respond
11 to this argument in its opposition. (*See* ECF No. 65.)

12 Under the doctrine of equivalents, “[a] patentee must establish equivalency on a
13 limitation-by-limitation basis by particularized testimony and linking argument as to the
14 insubstantiality of the differences between the claimed invention and the accused device or
15 process.” *See Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 811 F.3d 1334, 1342 (Fed. Cir.
16 2016) (quotations omitted). Broad, scant, conclusory statements of equivalence are insufficient.
17 *Id.* at 1342–43. “The party asserting infringement must present *evidence and argument*
18 concerning the doctrine and *each* of its *elements*.” *Lear Siegler, Inc. v. Sealy Mattress Co. of*
19 *Mich., Inc.*, 873 F.2d 1422, 1425 (Fed. Cir. 1989) (emphasis in original).

20 As Defendant correctly points out, Plaintiff has not identified which elements require the
21 doctrine of equivalents, has not raised separate arguments regarding the doctrine of equivalents,
22 and has not submitted any evidence on the issue. Plaintiff merely asserts “[t]o the extent that any
23 claim is not literally present [in] the accused products, [Plaintiff] contends that the claim(s) [are]
24 present under the doctrine of equivalents.” (ECF No. 66 at 7.) This is insufficient to create a
25 triable issue of fact. *See Lear Siegler, Inc.*, 873 F.2d at 1425 (“The evidence and argument on the
26 doctrine of equivalents cannot merely be subsumed in plaintiff’s case of literal infringement.”).
27 Therefore, the Court GRANTS summary judgment in favor of Defendant on the issue of
28 infringement of the ’700 patent under the doctrine of equivalents.

1 Because Plaintiff has not shown Defendant infringed the '700 patent either literally or
2 under the doctrine of equivalents, the Court GRANTS Defendant's motion as to Claim One based
3 on Defendant's noninfringement. *See Bayer AG*, 212 F.3d at 1247.

4 B. Claim Four ('292 Patent)

5 Defendant next argues it did not infringe the '292 patent because it did not use, offer to
6 sell, or import the Tile Replacement System after the issue date of the '292 patent. (ECF No. 64-
7 1 at 14–15.) More specifically, Defendant argues it is undisputed the '292 patent issued on
8 September 26, 2017, and Defendant did not sell any Tile Replacement System after April 11,
9 2017. (*Id.*)

10 In opposition, Plaintiff does not dispute that Defendant cannot be held liable for conduct
11 prior to the issue date of the '292 patent. *See* 35 U.S.C. § 271(a) (limiting acts of infringement to
12 “during the term of the patent”). Nor does Plaintiff dispute that Defendant has not sold an
13 allegedly infringing Tile Replacement System since the '292 patent issued. (ECF No. 65 at 10.)
14 However, Plaintiff argues “there is a factual dispute as to whether [Defendant] has *offered* the
15 infringing product for sale” after the patent issue date — which would constitute patent
16 infringement regardless of whether a sale occurred — because Defendant “continues to maintain
17 marketing materials for the Tile Replacement System on the internet.” (*Id.*) As evidence,
18 Plaintiff cites a PDF version of a document titled “S Tile Replacement System” Assembly Sheet,
19 which Stearns allegedly accessed via Google search on April 3, 2019. (ECF No. 66-1 at 4, 8.)

20 Patent infringement law establishes liability for an offer to sell “according to the norms of
21 traditional contractual analysis.” *MEMC Elec. Materials, Inc.*, 420 F.3d at 1376 (citing 35 U.S.C.
22 § 271(a)). In other words, “the defendant must communicate a manifestation of willingness to
23 enter into a bargain, so made as to justify another person in understanding that his assent to that
24 bargain is invited and will conclude it.” *Id.* (internal quotation marks and citation omitted).

25 In the instant case, Plaintiff fails to provide sufficient evidence to lend even a reasonable
26 inference that Defendant offered to sell the allegedly infringing product after the '292 patent
27 issued. First, although Stearns vaguely indicated he accessed the Assembly Sheet via a Google
28 search in 2019, there is no date on the Assembly Sheet itself and Plaintiff fails to provide

1 evidence that Defendant made the Assembly Sheet accessible in such a way that might suggest
2 the product has been offered for sale after the patent issue date. Second, the Assembly Sheet does
3 not contain any price terms and thus “cannot be construed as an ‘offer’ . . . [that could be made]
4 into a binding contract by simple acceptance.” *See id.* (finding product descriptions did not
5 constitute an offer to sell); *see also 3D Systems, Inc. v. Aarotech Laboratories, Inc.*, 160 F.3d
6 1373, 1379 (Fed. Cir. 1998) (finding an offer to sell where the defendants provided potential
7 California customers with price quotations, brochures, specification sheets, videos, and sample
8 parts related to their product). Accordingly, no reasonable jury could find that the Assembly
9 Sheet — Plaintiff’s sole evidence on the issue — shows that Defendant offered to sell the Tile
10 Replacement System after the ’292 patent issued.

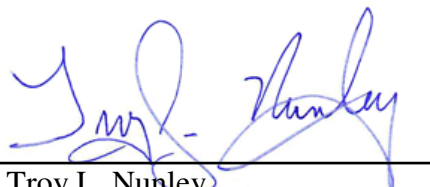
11 As such, the Court GRANTS summary judgment in favor of Defendant as to Claim Four
12 based on Defendant’s noninfringement of the ’292 patent. *See Bayer AG*, 212 F.3d at 1247.

13 **IV. CONCLUSION**

14 For the foregoing reasons, the Court GRANTS Defendant’s Motion for Summary
15 Judgment. (ECF No. 64.) Because Plaintiff has failed to produce evidence sufficient to show
16 infringement of any of the Asserted Patents, the Court declines to rule on Defendant’s invalidity
17 defense. Further, because the Court did not rely on any of the disputed materials attached to
18 Defendant’s reply, the Court DENIES Plaintiff’s Motion to Strike (ECF No. 69) as moot. The
19 Clerk of Court is directed to enter judgment in favor of Defendant on Plaintiff’s claims for
20 infringement of the following patents: U.S. Patent Nos. 8,153,700; 9,134,044; 9,447,988;
21 9,774,292; and 9,793,853. This case is closed.

22 IT IS SO ORDERED.

23 Date: November 8, 2021

24
25
26 
27 Troy L. Nunley
28 United States District Judge